

Art Unit: 2627

***35 U.S.C. 101 Rejection***

1. 35 U.S.C. 101 reads as follows:

*Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.*

2. Claims 13-18 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 13 is rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing (Reference the May 15, 2008 memorandum issued by Deputy Commissioner for Patent Examining Policy, John J. Love, titled "Clarification of 'Processes' under 35 U.S.C. 101"). In this case, Claim 13 is drawn to a computer readable recording medium storing a program to direct a computer to carry out a background formatting operation (lines 1 and 2). However, the claimed program fails to tie to another statutory category. For example, it is not clear what elements and means performing the operation "carry out a controlling step of ...." and therefore, it is unknown that whether the stored program is used to control any elements

Art Unit: 2627

and means for positioning the claimed recording/playing data.

In other words, the instant claim neither transforms underlying subject matter nor positively ties to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. [Note: I do not understand this rejection. These claims are directed to computer readable medium, not a method. The question is whether the medium is tangible or not.]

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

*The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.*

4. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding Claim 1, last two lines, the phrase "from being too far apart from a position" is vague because the meaning of "too far apart" is indefinite. First, it is not clear whether it is the "recording/playing unit" or the "data" is being too far apart. Second, the claim has no indication of what is

Art Unit: 2627

meant by "too far apart" with respect to the recording medium's recording unit such as "sector", track" or layer etc.

Similarly, in each of independent Claims 7 and 13, the phrase "from being too far apart from a position" is vague because the meaning of "too far apart" is indefinite as explained above.

The claims not specifically mentioned above are rejected because these claims are dependent on the rejected base claims.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless --  
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.*

6. Claims 1-18 are rejected under 35 U.S.C. § 102(b) as being anticipated by Hashimoto (U.S. Patent 6,172,955).

7. Hashimoto teaches an information recording and playing apparatus having all of the elements and means as recited in claims 1\$%\$\$\$\$\$. For example, Hashimoto teaches the following:

Regarding Claim 1, the information recording and playing apparatus (Fig. 1) comprising a recording/playing unit 6 (Fig.

Art Unit: 2627

1) to perform a background formatting (abstract) on a rewritable recording medium 1 together with a recording/playing of data (abstract; other process) on the rewritable recording medium 1 according to a user's request (recording/playing, formatting are user request operation), wherein the information recording and playing apparatus further comprises a control unit 9 (Fig. 1) to prevent a position (stored data location) where the recording/playing of data on the rewritable recording medium 1 is completed (data recorded/accessed; column 2, lines 49-52)) from being too far apart (within the medium; without waiting a long time) from a position where the background formatting is to be started (Figs. 1 and 7; column 8, lines 48-52).

Regarding Claim 2, in a case where a user makes a request of recording/playing data, the control unit performs the recording/playing of the data according to the request, and wherein after the recording/playing of the data according to the request is completed, the control unit prevents the position where the recording/playing of the data is completed from being too far apart (within the medium; without waiting a long time) from the position where the background formatting is to be started (Figs. 1 and 7; column 8, lines 48-52).

Regarding Claim 3, in a case where the user makes a request of recording/playing data while the background

Art Unit: 2627

formatting is in process, the control unit performs the recording/playing of the data according to the request, after the recording/playing of the data according to the request is completed, the control unit compares (access data locations) the position where the recording/playing of the data is completed with the position where the background formatting is to be started, and if the positions are apart from each other by greater than a predetermined distance (recording errors such as tracking errors), the control unit suspends (inherent features where stop because of tracking errors) the background formatting so as to prevent the position where the recording/playing of the data is completed from being too far apart from the position where the background formatting is to be started (Figs. 1 and 7; column 8, lines 48-52).

Regarding Claim 4, in a case where the user makes a request of recording/playing data while the background formatting is in process, the control unit performs the recording/playing of the data according to the request and measures a time (inherent feature; data access requires the speed of the disc be controlled/known) from when the recording/playing of the data according to the request is completed, if the measured time is over a predetermined period (tracking error), said control unit compares the position where the recording/playing of the data is

Art Unit: 2627

completed with the position where the background formatting is to be started, and if the positions are apart from each other by greater than a predetermined distance, the control unit suspends the background formatting so as to prevent the position where the recording/playing of the data is completed from being too far apart from the position where the background formatting is to be started (Figs. 1 and 7; column 8, lines 48-52).

Regarding Claim 5, the predetermined distance (tracks/addresses) is variable in accordance with characteristics of the recording/playing unit 6 and a circuit configuration of the recording/playing unit (Fig. 1; density of the tracks such as CD or DVD determines the structure of a pickup up head).

Regarding Claim 6, the data are streaming data (Fig. 2; data are recorded in strings).

8. Method claims 7-12 are drawn to the method of using the corresponding apparatus claimed in claims 1-6. Therefore method claims 7-12 correspond to apparatus claims 1-6 and are rejected for the same reasons of anticipation as used above.

9. Claims 13-18 have limitations similar to those treated in the above rejection, and are met by the reference as discussed above. Claims 13 however also recites the following limitation which is also taught in the prior art of Hashimoto:

Regarding Claim 13, A computer readable recording medium 1 (Fig. 1) storing a program (stored data such as song, laser light calibration data can be considered as a program) to direct (link/exchange data with) a computer (Fig. 1; host computer) to carry out a background formatting (Fig. 1; medium 1 having stored data is used during background formatting).

#### ***Related Prior Art***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Liu et al. (6424978) is pertinent because Liu teaches a recording medium formatting system.

Art Unit: 2627

11. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Kim CHU whose telephone number is (571) 272-7585 between 9:30 am to 6:00 pm, Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Nguyen, can be reached on (571) 272-7579.

The fax number for the organization where this application or proceeding is assigned is (571) 273-8300

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/Kim-Kwok CHU/  
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